Response to Rejection of Claims 36 to 39 under 35USC103

1. The Examiner rejected claims 36 to 39 over Jones (US 5,741,491) in view of Yang et al. Pursuant to 35 U.S.C. 103:

"(a) A patent may not be obtained thought the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

2. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

3. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Jones (US 5,741,491) which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Yang et al. at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Desirability Suggestion

4. The Examiner appears to reason that since one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, and that the ordinary artisan would have been motivated to combine the herbs even if Applicant combined the herbs for a different reason, and that what would be expected form one of ordinary skill in the art, in light of the combination of references, is that because each individual herb is known in the art for treating diabetes, that the combination of herbs would provide for an additive effect: "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be

useful for the same purpose, in order to form a third composition to be used for the very same purpose.

5. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. *See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

6. In the present case, there is no such suggestion. In oriental medicine, all herbal medicine dose is a combination of known herbs in specific proportions for treatment of know or unknown sickness. According to the Examiner's allegation, all new inventions in combination of known herbs for new diseases are not patentable, no matter whether there is any suggestion of combining these known herbs in specific proportion for such disease, merely because the combined herbs are known in art. Or that according to the Examiner's allegation, the "Cocktail Treatment" of Dr. Ho in AIDS contains no innovative art if Dr. Ho fails to use any new invented or discovered medicine in combination but in fact it is generally a combination of known medicine in specific proportion. Thus, it is apparently not a proper allegation. Accordingly, applicants believe that the rejection of claim 36-39 is improper and should be withdrawn.

7. The applicant respectfully submits that the instant invention as claimed in the claims 36 to 39, at the time the invention was made, is ***unobvious*** to a person having ordinary skill in the art, due to the following reasons:

Referring to claim 36, Jones discloses a composition comprising plant materials derived from Heracleum lanatum for treating diabetes. Jones discloses six tables (Tables 1 to 6) for showing the effect of Heraceleum lanatum in lowering glucose level. Referring to Table 1 to Table 6 of Jones patent, glucose level improvement (i.e. lowering of glucose level) does not occur in all subject groups. For some subject groups, the glucose level is even "unchanged". All of the tables show that the outcomes of the claimed composition in Jones patent are obtained after ***FOUR WEEKS*** treatment period.

On the other hand, Yang et al. discloses Toona sinensis leaf extract for enhancing glucose uptake in 3T3-L1 adipocytes. Significantly, Yang et al. states that "Cellular glucose uptake with a combination of Toona sinensis leaf extract and insulin was significantly inhibited by pre-treatment of cells with the protein synthesis inhibitor cycloheximide and the protein kinase C inhibitor calphostin C in normal-, medium- and high-glucose media." Thus, it is clear that the use of Toona sinensis leaf extracts for treatment of diabetes is limited.

Unexpected Result

8. Accordingly, Jones and Yang et al. do not in way teach, suggest, or motivate the use of a combination of Heracleum lanatum and Toona sinensis leaf extract to significantly enhance the performance of diabetes treatment, and in particular, minimization of the time required to achieve significant reduction of glucose level. It is submitted that according to experimental results of the instant invention, a majority of subject has a reduction of glucose level by at least 20% after 30 days of treatment. This is an ***unexpectedly good*** performance and is more than a mere additive effect of Heracleum lanatum and Toona sinensis leaf extract.

9. Referring to claims 38 to 39, Jones and Yang et al. do not specifically teach, suggest or motivate a combination of Heracleum lanatum and Toona sinensis leaf extract for the treatment of diabetes. Thus, there is no motivation or suggestion in both Jones and Yang et al. or a combination of both that a specific composition of Heracleum lanatum and Toona sinensis leaf extract would lead to an unexpectedly good performance of diabetes treatment.

The Cited but Non-Applied References

10. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

11. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by Express Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 05/04/2007 Signature:
Person Signing: Raymond Y. Chan